

REMARKS

Claims 1-9, 16-18, 28-31, 35-37, 39-47, 52-54 and 92-93 are pending. Claims 19-27, 32-34 and 38 are canceled. Claims 48-51 and 55-91 have been withdrawn from consideration. Claims 92 and 93 have been added. Reconsideration of the application is requested.

§ 103 Rejections

Claims 1-9, 16-18, 28-31, 35-37, 39-47 and 52-54 have been rejected under 35 USC § 103(a) as being unpatentable over WO 96/08229 by itself or in view of US 5,993,849. Applicants in their Appeal Brief, dated November 10, 2008, have presented reasons why this rejection is in error and Applicants respectfully request that the Examiner reconsider those arguments. Applicants supplement those reasons with the following.

The Examiner on page 11 of the Examiner's Answer argued as follows in relation to Roy et al.:

"The relative low skin flux rate disclosed by Roy et al. would have been a motivation to one having ordinary skill in the art to add more than 4% fentanyl since Roy disclosed that acrylate has high fentanyl solubility in order to obtain higher skin flux rate."

However, this statement by the Examiner ignores totally the conclusion of the authors themselves found in the right hand column on page 495 of Roy et al. There the authors conclude the following:

"Because of low drug solubility, a high diffusion coefficient, and a low $K_{p/s}$, the silicone-2920 adhesive appears to be a very promising adhesive candidate for designing a transdermal device with minimum drug loading to sustain the delivery of fentanyl at a desired rate to induce analgesia in humans for the relief of acute and chronic pain."

Hence, contrary to the Examiner's assertion, Roy et al. does not teach or suggest the use of adhesives having a high fentanyl solubility. In fact, Roy et al. actually teaches away from the use of acrylates in transdermal fentanyl delivery devices, particularly a transdermal fentanyl delivery device containing a relatively high amount of fentanyl such as about 8% to about 30% by weight based upon the total weight of the composition as recited by Claim 1.

In summary, the rejection of claims 1-9, 16-18, 28-31, 35-37, 39-47 and 52-54 under 35 USC § 103(a) as being unpatentable over WO 96/08229 by itself or in view of US 5,993,849 has been overcome and should be withdrawn. New claims 92 and 93 are also considered by Applicants to be allowable over the prior art for the same reasons expressed above and previously.

In view of the above, it is submitted that the application is in condition for allowance.

Respectfully submitted,

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